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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/988,496   | 11/20/2001  | David J. Anderson    | CTCH-P01-007        | 8536             |
| 28120  | 7590        | 01/07/2004           | EXAMINER            |                  |
| ROPES & GRAY LLP<br>ONE INTERNATIONAL PLACE<br>BOSTON, MA 02110-2624 |             |                      | SHUKLA, RAM R       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1632                |                  |

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,496

Applicant(s)

ANDERSON ET AL.

Examiner

Ram R. Shukla

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-40 and 73-86 is/are pending in the application.
- 4a) Of the above claim(s) 32-38, 40 and 74-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39 and 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election of the invention of group V, claim 39 in Paper filed 10-3-2003 is acknowledged.
2. Applicant's election with traverse of the invention of group V in Paper 10-3-2003 is acknowledged. The traversal is on the ground(s) that a search encompassing all thirteen groups would not be significantly more arduous than a search of any one group alone. This is not found persuasive because as noted in the previous office action of 8-27-2003, the thirteen groups are unrelated and would require separate and independent search. Additionally, it is noted that it is not just the burden of search but of both search and examination for which restriction is required. Additionally, applicants' arguments that the groups IV and V are so related that a search of one of these groups, of necessity, constitute a nearly complete search of the other group, are not persuasive because searching for making of arterial smooth muscle cells will not yield art related to screening of compounds using the cells.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 32-38 and 40 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper filed 10-3-2003.
4. Newly submitted claim 74-86 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly presented claims are not related to the invention of the elected invention because the invention of claims 74-86 are drawn to a method of screening for compounds by combining two polypeptides in presence of an agent and then determining whether the agent interferes the interaction between the polypeptides, the elected invention on the other hand is drawn to a method of screening for agents that affect arterial smooth muscle cells. Therefore, the invention of claims 73-86 is

independent and patentably distinct from the invention of group V, the elected invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 74-86 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. It is noted that claim 73 depends from claim 38, however since it is directed to a method and claim 39 not claim 38 is a method claim, claim 73 is interpreted to depend from claim 39. Accordingly, claim 73 has been considered to the extent it encompasses the invention of claim 39.

6. Claim 39 and 73 are under consideration.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29,

2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 39 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al (Stroke 29:1188-1193, 1998).

Yamamoto et al teaches culturing of arterial smooth muscle cells and effect of mitogens on these cells (see the materials and methods section on page 1189 and figure 2).

Therefore, Yamamoto et al anticipates the invention of claims 39 and 73.

9. Claims 39 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Haber et al (US Patent 6,440,954 B1, 8-27-2002, effective filing date 8-18-1997).

The cited US patent teaches rat arterial smooth muscle cells in culture and their treatment with different compounds (see columns 5 and 6).

Therefore, Haber et al anticipates the invention of claims 39 and 73.

10. Claims 39 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Olson et al (US Patent 6,015,711, 1-8-2000, filing date 7-28-1998).

The cited US patent teaches rat arterial smooth muscle cells in culture and their treatment with compounds (see column 12, lines 63-67 continued in column 13).

Therefore, Olson et al anticipates the invention of claims 39 and 73.

11. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is

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(703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for TC 1600 is (703) 703-872-9306. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3413.

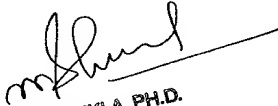
Please note that effective January 13, the offices for Examiner Shukla, SPE Reynolds and LIE William Phillips will move to the new USPTO location in Alexandria, VA and their phone numbers will change. The new phone numbers will be as follows:

Ram Shukla: **(571) 272-0735**

Deborah Reynolds: **(571) 272-0734**

William Phillips: **(571) 272-0548**

Ram R. Shukla, Ph.D.  
Primary Examiner  
Art Unit 1632

  
**RAM R. SHUKLA, PH.D.**  
**PRIMARY EXAMINER**